UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,790	06/23/2003	Peter Meerwald	282562US8X	1686

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER
PHAM, THIERRY L

ART UNIT	PAPER NUMBER
2625	

NOTIFICATION DATE	DELIVERY MODE
02/20/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 November 2008*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *20,22-25 and 27-32* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *20, 22-25, 27-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

● This action is responsive to the following communication: an amendment filed on 11/24/2008.

● Claims 20, 22-25, 27-32 are currently pending; claims 1-19, 21, 26 have been canceled.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20, 22-25, 27-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

For instance, independent claim 23, page 3, line 5, the newly added claimed recitation of "*areas within said disk that are protected" is* subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification at page 8, line 30-38, only discloses "a disk" (see specification, page 8, lines 30-38), however, the specification does not disclose or mentions "areas within said disk that are protected". Independent claims 27 & 32 are rejected for the same basis as claim 23. Claims 20, 22, 24-25, 28-32 are dependent upon rejected claim(s), therefore, are rejected for the same rationale.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23, 27, 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For example, claim 23 recites the limitation "said disk" on page 3, line 5. There is insufficient antecedent basis for this limitation in the claim.

For instance, on claim 23, page 3, line 5, the claimed recitation of "said disk" lacks proper or clear antecedent basis. In claim 23, in page 3, line 5, it is unclear as to which disk "said disk" is referring to? Is it the "disk label"? (found in claim 23, page 3, line 2), or is it the "disk category" (found in claim 23, page 3, line 3)?, or is it the "disk type" (found in claim 23, page 3, line 3)? Clarification is required. For the purpose of the prior art rejection(s), the examiner herein interprets the claimed "said disk" as optical disk.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 20, 22-25, 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Valer (US 6714209), and in view of McFarland et al (US 6903760), and further in view of Schneider (US 6363487).

Regarding claim 23, Valer discloses a system (system as shown in fig. 5) for performing processes used for generating printing data on the basis of which a disk label is creatable (creating disk label, fig. 4), comprising:

● a network capable client (PC 100, fig. 1) configured to locally control/perform (locally generating/creating disk label using local web browser, fig. 4) said

processes used for generating printing data on the basis of which a disk label is creatable (disk label, fig. 4); and

● a network capable server (server 520, fig. 5) configured to offer functionality directly usable on said network capable client (disk label creating functionality via web browser, fig. 6, col. 2, lines 50-65 and col. 11, lines 5-67), wherein said functionality is adapted to locally control/perform (users locally creating disk label via using web browser, fig. 3-5, col. 11, lines 5-67) said processes used for generating printing data on the basis of which said disk label is creatable, wherein said network capable client and network capable server are connected with each other via a communication network (network, fig. 5), wherein said printing data are generated based on graphic data representing said disk label (Valer also allows users to preview the TOC disk label before printing, col. 3, lines 45-49), wherein, in advance of finalizing said graphic data for said disk label (finalizing before sending to print, fig. 6), a disk label is determined in dependence on a disk category and a disk type (Valer also teaches plurality of disk types incluing CD, DVD, CD-R, DVD-RAM, and etc, cols. 4-5) selected by a user.

McFarland, in the same field of endeavor for printing disk labels, teaches a program that has functionalities that control processes for generating print data on a basis of which a disk label is creatable and is installable in client device (e.g. client pc) and does not teach a disk label printing area is determined in dependence on selection by a user of a disk category and a disk type, wherein said category defines overall dimensions for disks of each disk category, wherein from said disk type areas are derivable which are prohibited from being labeled for said disk category, and the printing data is presented to the user at a first resolution and to rescale it to the second/higher resolution.

McFarland, in the same field of endeavor for printing disk labels, teaches a program that has functionalities that control processes for generating print data on a basis of which a disk label is creatable and is installable in client device *(programs for creating disk label can be generated by way of computer*

program using high level of programming languages such as C++, JAVA, and etc and stored in computer 120, fig. 1. col. 6, lines 25-28) and a disk label printing area is determined in dependence on selection by a user of a disk category and a disk type *(label page layout is displayed dependence upon the type of disk selected by users, col. 5, 55-67 and col. 8, lines 46-57)*, wherein said category defines overall dimensions *(e.g. size of disk media such as 8cm or 12 cm, col. 5, lines 13-45)* for disks of each disk category, wherein from said disk type areas are derivable which are prohibited *(fig. 4 shows there are certain areas that would be outside the label area corresponding to the area of the CD and are blocked from printing and/or not printing on the CD printable area, col. 5, lines 25-30)* from being labeled for said disk category, and the printing data is presented to the user at a first resolution and to rescale *(image rescaling, col. 6, lines 35-40)* it to the second resolution.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify printing system of Valer to include a program that has functionalities that control processes for generating print data on a basis of which a disk label is creatable and is installable in client device (e.g. client pc) and a disk label printing area is determined in dependence on selection by a user of a disk category and a disk type, wherein said category defines overall dimensions for disks of each disk category, wherein from said disk type areas are derivable which are prohibited from being labeled for said disk category, and the printing data is presented to the user at a first resolution and to rescale it to the second/higher resolution because of the following advantages: (1) it allows users to create disk label locally (by installing program at client device) or remotely (using program stored in remote server); (2) automatically displays page layout based upon user's selection of disk type/category (col. 5, lines 55-67) that allows user to create disk label more efficiently/effectively; (3) automatically rescaling the image to a second resolution (size) so the image can fit on a given media size (e.g. 8 cm or 12 cm).

The combination of Valer and McFarland fail to teach and/or suggest wherein areas within the disk that are protected are prohibited from being labeled.

Schneider teaches an example of wherein protected areas within an optical disk are prohibited from being labeled/write upon (fig. 3, col. 2, lines 32-44).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Valer and McFarland to include a method of preventing writing/labeling data on a protected areas of the optical disk as taught by Schneider in order to prevent protected areas from being overwritten by accident or without user permission.

Therefore, it would have been obvious to combine Valer and McFarland with Schneider to obtain the invention as specified in claim 23.

Regarding claims 20 & 31, combination of Valer and McFarland further teach wherein the network client is configured to download an applet from the network capable server, and the applet is used in conjunction with a web browser to select the disk category and disk type in order to generate the graphic data for the disk label. Valer teaches a disk label program using XML format and wherein disk label program as taught by McFarland can be programmed in any high level language including JAVA language, therefore, it would have been obvious to construct Valer's disk label program in a different language (for example, JAVA applets as taught by McFarland) so that user can download and install it at their local device.

Regarding claim 22, Valer further teaches the network capable server according to claim23, wherein printing data being remotely generated by said remote client is received (via network 510, fig. 5).

Regarding claim 24, Valer further discloses the system according to claim 23, wherein said communication network comprises the Internet (Internet 510, fig. 5) and/or an Intranet.

Regarding claims 29-30, combinations of Valer and McFarland further teach the system according to claim 23, wherein said graphic data are generated by graphic tool, which is part of an applet, having a drawing functionality. Valer teaches a disk label program using XML format and wherein disk label program as taught by McFarland can be programmed in any high level language including JAVA language, therefore, it would have been obvious to construct Valer's disk label program in a different language (for example, JAVA applets as taught by McFarland) so that user can download and install it at their local device.

Regarding claims 25, 27-28, 32 recite limitations that are similar and in the same scope of invention as to those in claims 23-24 above; therefore, claims 25, 27-28, 32 are rejected for the same rejection rationale/basis as described in claims 23-24.

Response to Arguments

Applicant's arguments with respect to claims 23, 27, and 32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THIERRY L. PHAM whose telephone number is (571)272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thierry L Pham/

Art Unit 2625

/Dov Popovici/

Primary Examiner, Art Unit 2625